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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,396	04/07/2000	Robert Seliger	S1389/7008 GSe	2452

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EXAMINER

JACOBS, LASHONDA T

ART UNIT

PAPER NUMBER

2157

DATE MAILED: 09/25/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/545,396

Applicant(s)

SELIGER ET AL.

Examiner

LaShonda T. Jacobs

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

This Office Action is an response to Applicant's amendment filed on June 27, 2003. Claims 1-22 are presented for further examination.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-22 are rejected under 35 U.S.C. § 101 because they are directed to non-statutory subject matter.

An invention may be patented only if it falls within one of the four statutory classes of subject matter of 35 U.S.C. § 101. Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 483, 181 USPQ 673, 679 (1974). The CCPA stated that "any process, machine, manufacture, or composition of matter constitutes statutory subject matter unless it falls within a judicially determined exception of section 101." In re Padro, 684 F.2d 912, 916, 214 USPQ 673, 677 (CCPA 1982). The claims are directed to non-statutory subject matter because the claimed subject matter does not fall within any of the four statutory classes of U.S.C. 101.

Claims 1 and 22 are directed to a computer program (or 'program product') and not to a computer implemented process or apparatus. Claim 1 and 22 reciting 'A method of administering a context management system that manages context....', is understood to be directed to software.

The claim is not directed to a computer implemented process, i.e., to a series of steps performed by a computer, which processes were held by the CCPA to constitute statutory subject

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matter unless within a judicially determined exception to 101. See "Patentable Subject Matter -- Mathematical Algorithms and Computer Programs," 1106 Off. Gaz. Pat. Office 5, 10-11 (Sept. 5, 1989); In re Gelnovatch, 595 F.2d 32, 44, 201 USPQ 136, 147 (CCPA 1979) (what is usually at issue "is not the 'program' i.e., the software, but the process steps which the software directs the computer to perform"); In re Johnson, 589 F.2d 1070, 1081, n.12, 200 USPQ 199, 210 N.12 (CCPA 1978).

In this analysis, as parallel may be drawn to the inquiry used in determining whether a claim having a mathematical algorithm is directed to non-statutory subject matter or to a statutory process. See In re Abele, 684, F.2d 902, 907, 214 USPQ 682, 687 (CCPA 1982): "The goal is to answer the question 'What did applicants invent?' Here the claim preamble recitations are so broad that it is manifest that the invention sought to be patented is the 'program product' (really, the computer program itself)".

As per claims 1 and 22, a context management system for "managing context..., administration suite for configuring a subject data definition.." is directed to components of a computer program (or 'program product') and not to a computer implemented process or apparatus. Claims 1 and 22 reciting '...a context management system, comprising:...means for configuring a subject data definition...context..' is directed to a program configuring a subject data definition that comprises a data item usable by a plurality of applications where the value of the data items are being exchange between the applications; therefore, the scope of the claim is directed to a non-statutory subject matter.

Non-statutory subject matter cannot be automatically converted into statutory matter merely by broadly labeling the claim as a 'method/apparatus for a host to invoke a complex in-circuit emulation test of a target..' or by drafting the claims with token references to something that is statutory subject matter. This form of draftsmanship would amount to elevating form over substance.

It is suggested that the claims be amended to recite means within a computer-implemented apparatus such that the software program when executed by a computer enables the computer to perform the desired functions.

### ***Response to Arguments***

The Office notes the following arguments:

- a. Hayes does not disclose or suggest configuring a subject data definition that defines subject data comprising a data item usable by a plurality of applications, wherein the value of the data item corresponding to a first application is exchangeable with the value of the data item corresponding to a first application when a user switches from the first application to the second application to retain a context.
- b. Hayes does not disclose or suggest many of the limitations recited by amended claim 1. First, Hayes does not disclose a data item usable by a plurality of applications.
- c. Hayes does not disclose data items, which are usable by more than one of the configured applications.
- d. Hayes does not disclose a data item having a set of values comprising at least a first value corresponding to a first application and a second value corresponding to a second application, the set of values identifying the subject in the context, the value of the data item corresponding to the first application being exchangeable with the value of the data item corresponding to the second application when a user switches from the first application to the second application to retain the context. Hayes simply does not disclose or suggest this capability.

e. Hayes does not disclose or suggest a method of administering a context management comprising configuring a subject data definition which defines a subject in context using subject data that comprises a data item usable by a plurality of applications comprising at least a first application and a second application, the data item having a set of values comprising at least a first value corresponding to the first application and a second value corresponding to the second application, the set of values identifying the subject in the context, the value of the data item corresponding to the first application being exchangeable with the value of the data item corresponding to the second application when a user switches from the first application to the second application to retain the context, as recited in claim 1.

f. Hayes does not disclose or suggest an administration suite for configuring a subject data definition which defines a subject in the context using subject data that comprises a data item usable by a plurality of applications, wherein the value of the data item corresponding to first application is exchangeable with the value of the data item corresponding to a second application when a user switches from the first application to the second application to retain a context.

In response to (a)-(f), Applicant's arguments are subjected to non-statutory matter.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShonda T. Jacobs whose telephone number is 703-305-7494. The examiner can normally be reached on 8:30 AM - 5:00 PM.

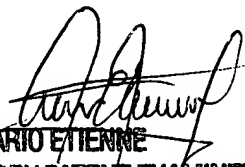
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-308-7562. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

LaShonda T. Jacobs  
Examiner  
Art Unit 2157

ltj  
September 17, 2003

  
**ARIO ETIENNE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**